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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/259,619	03/01/1999	TIMOTHY LABADIE	210655.90018	5502

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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/259,619	<b>Applicant(s)</b> LABADIE ET AL.	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,8-11,13,14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,9-11,13 and 14 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 8, and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-4, 8-11, 13, 14, and 16 are pending in this communication filed 12/19/05 entered as Notice of Appeal and Request for Extension of Time and on 02/14/06 entered as Appeal Brief filed.
2. In view of the Appeal Brief and Amendment/Argument filed on 2/14/06, PROSECUTION IS HEREBY REOPENED. New grounds of rejection as set forth here below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is no-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however the appeal fees set forth in 37 CFR 41.20 have increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing on the last page of this Office Action.

### ***Drawings***

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings filed are informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and

Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the following elements in Figure 1: elements “18, 28, 37, 38, 40, 42, 50, 44, 46, and 48” and in Figure 2: elements “66, 75, and 74” as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 2, reference characters "16" and "24". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The Specification is objected to because it cannot be determined from Applicants' Specification what reference characters are for which drawing figures beginning on page in line 4- page 10, line 29. The drawing description for Figure 3 is missing. The added D1 amendment is missing from the application file in IFW (e-Dan).

A substitute specification is required pursuant to 37 CFR 1.125(a) because of the reasons stated above.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the

immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

### ***Claim Objections***

5. Claim 1 objected to because of the following informalities: Claim 1 recites in Appendix A, line 10 "the Internet: and". This line would be better recited as "the Internet;". Line 19 recites "..., and further including bank routing information;". This line would be better recited as "..., and further including bank routing information; and". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 2, and 9-13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 11-19 recite "... the processor computer further including a data structure matching the customer identifier to at least one statistical element without communication with the third party bank, a probability of a payment obligation by the customer being honored, and based on that matching statistical element transmitting to the merchant computer ... ". The following limitation to this claim appears to be out of place in connecting the remainder of the claim limitation: "..., a probability of a payment obligation by the customer being honored". There appears to be a disconnect in the claim language. It is unclear and confusing what Applicant is trying to say.

Claims 9 and 13 recite "unique customer identifier".

Claims 10,11, and 14 recite "customer identifier".

Thus, it is unclear whether there is a "unique customer identifier" and a "customer identifier". If there is only one "customer identifier" the claim language needs to be amended to recite either "customer identifier" or "unique customer identifier".

Claim 1 recites the limitation "unique customer identifier" on page 11, line 9 of Appendix A. Claim 2, line 4 recites "unique customer identifier" and line 5 recites "customer identifier". There is insufficient antecedent basis for this limitation in the claim.

### **Suggested Claim Amendments**

8. It is suggested to add and to clarify in the claim language "the statistical elements are not security related". The "authorization" element in claim limitation three is considered to be a security feature. It is unclear to the Examiner how the matching of the customer identifier takes place to a selection of the check payment option then the data structure matching the customer identifier to at least one statistical element without

the communication with the third party bank. Why is the “statistical element” not considered a security feature”? What is this a “statistical element”? The third limitation needs to be more clearly written because as written it is very unclear. It is suggested to break part of the limitation apart like limitations one, two, and four. Also to add “Internet check payment” in the body of the claim.

Applicant might consider adding some claim language relating to the merchant needing a statistical understanding of the risks of accepting a check from the customer in order to have an understanding this takes place. It is unclear as to the “statistical elements” that indicate probability of a payment obligation by the customer being honored. Clarification in the claim language is respectfully requested.

***Allowable Subject Matter***

9. Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
10. Claims 2, 9-11, 13-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
11. Claims 3, 4, 8, and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
12. The following is a statement of reasons for the indication of allowable subject matter: “a processor computer independent from the customer computer and the merchant computer programmed to receive at least one customer identifier in response



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to a selection of the payment by check option, the processor computer further including a data structure matching the customer identifier to at least one statistical element without communication with the third party bank and based on that matching statistical element transmitting to the merchant computer an authorization indication indicating whether check payment for the product should be accepted" in independent claim 1 is allowable over the prior art of record.

### Inquiries

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
ELLA COLBERT  
PRIMARY EXAMINER

April 29, 2006

VINCENT MILLIN  
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